

**REMARKS**

In the Office Action the Examiner noted that claims 1-46 are pending in the application, and the Examiner rejected all claims. By this Amendment, claims 7 and 10 have been amended, and claim 8 has been cancelled without prejudice or disclaimer. No new matter has been added. Thus, claims 1-7 and 9-46 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

**Claim Rejections Under 35 USC §103**

In item 2 on pages 2-13 the Examiner rejected claims 1-46 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,236,727, issued to Ciacelli et al. (hereinafter referred to as "Ciacelli") in view of U.S. Patent No. 5,504,816, issued to Hamilton et al. (hereinafter referred to as "Hamilton") and U.S. Patent No. 5,293,422, issued to Loiacono (hereinafter referred to as "Loiacono"). The Applicant respectfully traverses these rejections by the Examiner.

Claim 1 of the present application recites:

An apparatus to convert original content data into a different coding system to generate converted content data and to copy the converted content data instead of the original content data, comprising:

a coding method confirming unit to confirm an original coding method applied to the original content data;

a transcopying unit to convert the original content data into copied content data that is decodable according to a different coding method; and

a management information recording unit to record information indicating that the original content data has been copied in a management information area of the original content data, and to record information indicating that the copied content data has been transcopied from the original content data in a management information area of the copied content data.

Therefore, the management information recording unit of claim 1 of the present application records "information indicating that the original content data has been copied in a management information area of the original content data," as well as "information indicating that the copied content data has been transcopied from the original content data in a management information area of the copied content data." In other words, both the original content data and the copied content data have respective management information areas. The management information area of the original content data indicates that the original content data has been

copied, in response to the original content data being copied, and the management information area of the copied content data indicates that the original content data has been copied and converted to a different coding method from the original content data.

The Examiner apparently acknowledges that neither Ciacelli nor Hamilton discloses the management information recording unit as recited in claim 1 of the present application. Ciacelli discloses an apparatus that receives encrypted data, decrypts the data, and then encrypts the data again using a different encryption method before transmission of the data (Column 3, Line 25 through Column 4, Line 11). Similarly, Hamilton also discloses receiving encrypted signals, decrypting the signals, and then retransmitting the decrypted signals using a second encryption scheme that differs from the first encryption scheme (Abstract).

However, the Examiner indicates that the deficiencies of Ciacelli and Hamilton regarding the management information recording unit are cured by the disclosure of Loiacono. The Examiner states that Loiacono discloses a "copy management means with copy control employing counters" in Figures 1 and 2 of Loiacono. The Applicant respectfully submits that Loiacono does not cure the deficiencies of Ciacelli and Hamilton at least in regard to the management information recording unit.

Loiacono discloses a method and apparatus for providing consumable software for use with a personal computer (Column 2, Line 67 through Column 3, Line 1). The method disclosed in Loiacono teaches a diskette 13 which includes an electronic workbook to be completed by a designated user. A copy protected region 15 of the diskette 13 includes a user counter and a unit counter. When a user logs on to use the diskette 13, the number of users is decremented such that, if the number is 0, the new user is denied access. If the number of users is greater than zero or if the user is previously registered, a computer allows the user to access only those units of the workbook not yet completed as determined by the unit counter. (Col. 4, line 60 to col. 5, line 58; FIGs. 1 and 2 of Loiacono).

The diskette 13 is generally required in order to distribute the software on the diskette 13. However, where the program is installed on a hard drive of a computer, information is recorded on the diskette 13 to indicate that the diskette 13 is completely consumed to prevent the diskette 13 from being used or distributed further. (Col. 4, lines 1-12; col. 5, lines 30-49 of Loiacono). However, there is no suggestion that, if a copy of the software is made from the diskette 13 onto the hard drive, information is included in the copied program in addition to the diskette 13 in order to distinguish the copied program from the program on the diskette 13, or that the transfer

from the diskette 13 is made or should be made using a different coding method as compared to the software and other data recorded on the diskette 13. In other words, although the data on the diskette is altered when the program is installed on the hard drive of the computer, in order to indicate that the diskette can no longer be accessed, the data actually recorded on the hard drive is the same as the original data on the diskette (Column 5, Lines 30-49). Therefore, no information is recorded "indicating that the copied content data has been transcopied from the original content data in a management information area of the copied content data," as is recited in claim 1 of the present application.

For at least the reasons presented above, the Applicant respectfully submits that neither Ciacelli, Hamilton, nor Loiacono, either taken alone or in combination, disclose the elements recited in claim 1 of the present application. For a proper §103 rejection, the cited references must combine to teach all of the features of the application at issue.

Further, even if the cited references did in combination disclose all of the elements of claim 1 of the present application, and the Applicant respectfully submits that they do not, there is no motivation to combine Loiacono with Ciacelli or Hamilton. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that "[i]t would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ciacelli et al because re-encryption is the functional equivalents of the claim limitations." Even assuming, arguendo, that "re-encryption is the functional equivalents of the claim limitations," there would be no reason to combine the access counter disclosed in Loiacono with the re-encryption method disclosed in Ciacelli. The Examiner seems to be saying that because Ciacelli may be similar to some elements of the claim, then it follows that it would have been obvious to combine Ciacelli with Loiacono, which is neither logically sound nor sufficient evidence for a motivation to combine the references. The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and

cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

As a matter of fact, the disclosure of Ciacelli actually teaches away from Loiacono. The disclosure of Ciacelli "is particularly applicable to MPEG encoded and CSS encrypted video data such as employed by digital video disc (DVD) technology" (Column 2, Lines 48-50). By maintaining encryption of the data recorded on the DVD during any sort of transmission, unencrypted data "is not allowed to be resident in an accessible computer system structure, such as a host memory buffer or system bus to prevent theft of the clear [unencrypted] data" (Column 2, Lines 44-48). In other words, a user is able to have unlimited access to the data recorded on the DVD, and the information cannot be copied by others. Therefore, the disclosure of Loiacono, in which access times are limited and access is eventually terminated, would be contraindicated in a system which employs a DVD, because users of the DVD need unlimited access to the movies, music, etc., contained thereon. Thus, the disclosure of Ciacelli teaches away from any combination with Loiacono.

Therefore, for at least the reasons presented above, the Applicant respectfully submits that the cited references do not disclose the elements recited in claim 1 of the present application, and further that there is no motivation to combine the references. Thus, the Applicant respectfully submits that claim 1 of the present application patentably distinguishes over the cited references, and further respectfully requests the withdrawal of the §103(a) rejection.

Claims 2-4 and 43-44 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 2-4 and 43-44 also patentably distinguish over the cited references.

Claim 5 of the present application recites a content data structure stored on a recordable medium the content data comprising "a rights management information area to indicate to the recording and/or reproducing apparatus whether said content data is the original content data or the copied content data transcopied from the original content data such that the recording and/or reproducing apparatus distinguishes between the original and copied content data, and to indicate rights information related to data transcopying." Therefore, similar to the arguments

presented above regarding claim 1 of the present application, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 5, and thus claim 5 patentably distinguishes over the cited references.

Claim 6 depends from claim 5 and includes all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claim 6 also patentably distinguishes over the cited references.

Claim 7 of the present application, as amended, recites a method for transcopying data "wherein said converting the original content data comprises recording information indicating that the original content data was transcopied into the copied content data is recorded in a rights management information area of the original content data, and recording information indicating that the copied content data was transcopied from the original content data in a rights management information area of the copied content data." Therefore, similar to the arguments presented above regarding claim 1 of the present application, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 7, and thus claim 7 patentably distinguishes over the cited references.

Claims 8-9 and 45-46 depend from claim 7 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 8-9 and 45-46 also patentably distinguish over the cited references.

Claim 10 of the present application, as amended, recites a method for transcopying data "wherein said converting the original content data comprises recording information indicating that the original content data was transcopied into the copied content data is recorded in a rights management information area of the original content data, and recording information indicating that the copied content data was transcopied from the original content data in a rights management information area of the copied content data." Therefore, similar to the arguments presented above regarding claim 1 of the present application, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 10, and thus claim 10 patentably distinguishes over the cited references.

Claim 11 of the present application recites "an information recording unit to record information in one of the original and the copied content data that relates the original and the copied content data." The Applicant respectfully submits that this element is not recited in the cited references. While Loiacono does disclose recording information in an original data storage

to "indicate complete consumption of that medium" (Column 5, Lines 42-43), there is no information recorded in the original medium or the new medium that relates the original and the copied content data. And, as discussed before, this deficiency is not cured by the remaining cited references. Therefore, the Applicant respectfully submits that the cited references do not disclose at least this element of claim 11, and thus claim 11 patentably distinguishes over the cited references.

Claims 12-24 depend from claim 11 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 12-24 also patentably distinguish over the cited references.

Claim 25 of the present application recites a reverting unit to revert copied content data into corresponding original content data from which the copied content data was copied, comprising "a confirming unit to confirm that the copied content data corresponds to the original content data using identification information in the copied and original content data; and a control unit to change rights information in the copied and original content data so that the copied content data cannot be reproduced in a content player, and the original content data reflects that the copied content data cannot be reproduced." As discussed in the arguments above, the cited references do not change rights information in both the copied and original content data, and further do not confirm that the copied content data corresponds to the original content data using identification information in the copied and original content data. Therefore, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 25, and thus claim 25 patentably distinguishes over the cited references.

Claims 26 and 27 depend from claim 25 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 26 and 27 also patentably distinguish over the cited references.

Claim 28 of the present application recites an apparatus to distribute content data, comprising "a confirming unit to confirm that the copied content data corresponds to the original content data using identification information in the copied and original content data," as well as "a control unit to...insert identification information in the copied content data relating the copied contents data and the original content data, and to insert information in the original and copied content data indicating that the original content data was copied by said copying unit." The Applicant respectfully submits that at least these features are not disclosed in the cited

references. As stated before, Loiacono does not insert any information that relates copied and original data, and this deficiency is not cured by the remaining cited references. Nor does any of the cited references disclose using identification information in the copied and original content data to confirm that the copied content data corresponds to the original content data. Therefore, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 28, and thus claim 28 patentably distinguishes over the cited references.

Claims 29-33 depend from claim 28 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 29-33 also patentably distinguish over the cited references.

Claim 34 of the present application recites a computer-readable medium encoded with data that is readable by a computer, the medium comprising "identification information that indicates to the computer whether said content data is original content data encoded using a first encoding method, or is copied content data copied from the original content data and encoded using a second encoding method." None of the cited references suggest identification information to indicate whether the data is the original data in the first encoded form or copied data in the second encoded form. Ciacelli and Hamilton merely disclose encrypting the data using two different encryption forms, but suggest nothing of including information to indicate if the data is original or copied. Similarly, Loiacono does not suggest including information indicating whether the data is original or a copy of the original data. Therefore, for at least these reasons, the Applicant respectfully submits that the cited references do not disclose at least these elements of claim 34, and thus claim 34 patentably distinguishes over the cited references.

Claims 35-42 depend from claim 34 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 35-42 also patentably distinguish over the cited references.

#### Summary

In accordance with the foregoing, claims 7 and 10 have been amended, and claim 8 has been cancelled without prejudice or disclaimer. No new matter has been presented. Claims 1-7 and 9-46 are pending and under consideration.

It is respectfully submitted that none of the cited references, either taken alone or in

combination, teach or suggest the present claimed invention. There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 05/11/05

By: Thomas L. Jones  
Thomas L. Jones  
Registration No. 53,908

1400 Eye St., NW  
Suite 300  
Washington, D.C. 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510